

Remarks/Arguments

Claims 1-17 are pending in this application, and are rejected in the Office Action of August 24, 2005. Claim 12 is amended herein for grammatical purposes.

Re: Claims 16 and 17

Claims 16 and 17 are rejected under U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,850,218 issued to LaJoie et al. (hereinafter, "LaJoie et al."). Applicants respectfully traverse this rejection for at least the following reasons.

With respect to independent claim 16, Applicants point out that this claim includes:

- “selecting a first program for removing from a first list representing a list of programs selected for recording;
- selecting a second program for removing from a second list representing a list of programs purchased;
- determining whether said second program also appears on said first list; and
- removing, automatically, said second program from said first list if said second program appears on said first list” (see claim 16).

As indicated above, independent claim 16 defines a method in which a program is automatically removed from a first list of programs selected for recording in response to user removal of the program from a second list of programs selected for purchase. LaJoie et al. fails to teach or suggest the subject matter of independent claim 16.

On page 2 of the instant Office Action, the Examiner addresses claim 16 by stating:

“LaJoie et al. discloses that if a user attempts to record an Impulse Pay-Per-View (IPPV) event, set-top terminal 6 will display an interactive warning window 270 alerting the user that the program has not been purchased. If the user presses the “C” application definable key 252 to cancel the purchase, the barker is hidden and the user is returned to the previous menu (col. 21, l. 30-49)(Fig. 12). This functionality is also disclosed with respect to LaJoie et al.’s One-Touch Recording. If the user presses “C” with the purchase menu 496 displayed, the user is returned to the previous menu 492 (col. 29, l. 33-58)(Fig. 25). Thus, in canceling the program for purchase the program is automatically removed from a record list.”

The foregoing statement and cited passages of LaJoie et al. deal with situations where a user attempts to record a program that has not yet been purchased. In such situations, LaJoie et al. gives the user an opportunity to either buy the program (i.e., by pressing “B”), or to cancel the record request and accompanying warning (i.e., by pressing “C”). This is clearly distinguishable from the invention of claim 16 where a program has already been purchased, and thereby exists on the claimed “second list.” According to claim 16, when a user cancels the purchase of a previously purchased program that exists on the “second list”, this program is automatically removed from “a first list representing a list of programs selected for recording” if the program is on the “first list.” In this manner, the invention of claim 16 automatically removes a program from a first list of programs selected for recording in response to user removal of the program from a second list of programs selected for purchase. Accordingly, Applicants maintain that LaJoie et al. fail to teach or suggest the invention of claim 16, and respectfully request withdrawal of the rejection.

With respect to independent claim 17, Applicants point out that this claim includes:

“removing, in response to a user command, said program from a first list of programs representing programs scheduled for recording;
determining, in response to said user command, whether said program is also a purchased program;
enabling an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and
removing said program from a second list of programs representing purchased programs responsive to user selection of said option” (see claim 17).

As indicated above, independent claim 17 defines a method in which an on screen display option is provided so that a user is afforded an opportunity to cancel the purchase of a program in response to cancellation of recording the program. LaJoie et al. fails to teach or suggest the subject matter of independent claim 17.

On page 3 of the instant Office Action, the Examiner addresses claim 17 by stating:

“LaJoie et al. discloses that a single button may be operable to add an item to two different lists. Further, LaJoie et al. discloses removing a program from a list of programs to be purchased (col. 22, l. 25-31) or removing any timer (col. 22, l. 52-56)(Fig. 14) including recording timers. As stated in claim 16, LaJoie et al. also provides a conflict resolution method in which a user is presented with a warning menu when trying to record an IPPV event. Furthermore, LaJoie et al. provides that canceling a program purchase in this scenario, the recording of the program is also cancelled.”

The foregoing statement and cited passages of LaJoie et al. fail to teach or suggest the invention of claim 17. In particular, column 22, lines 25-31 of LaJoie et al. teach that a user can cancel a pending program purchase. Column 22, lines 52-56 of

LaJoie et al. teach that a user can cancel a recording (i.e., timer). However, LaJoie et al. provides absolutely no teaching regarding the coordination of these two events. In other words, LaJoie et al. teaches that canceling a pending program purchase is an entirely independent event from canceling a recording. As such, LaJoie et al. fails to even recognize the problem solved by the invention of claim 17 which provides an on screen display option so that a user is afforded an opportunity to cancel the purchase of a program in response to cancellation of recording the program. Accordingly, Applicants maintain that LaJoie et al. fail to teach or suggest the invention of claim 17, and respectfully request withdrawal of the rejection.

Re: Claims 1, 3, 6, 8 and 13

Claims 1, 3, 6, 8 and 13 are rejected under U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,025,868 issued to Russo (hereinafter, "Russo"). Applicants respectfully traverse this rejection for at least the following reasons.

It is first noted that independent claims 1, 6 and 13 include:

"an on screen user option indicating that a user can both purchase and record the selected program, so that the user does not have to select one of purchase and record user options and then select the other user option to purchase and record the selected program" (emphasis added - see claim 1),

"on screen user control option indicating that a user can both purchase and record a program, so that the user does not have to select one of purchase and record user control options and then select the other user control option to purchase and record said program" (emphasis added – see claim 6), and

"receiving a selection of a displayed user option indicating that a user can both purchase and record the selected second program, so

that the user does not have to select one of purchase and record user options and then select the other user option to purchase and record the selected second program” (emphasis added – see claim 13).

As indicated above, independent claims 1, 6 and 13 each provides a user option that enables a user to both purchase and record a program without having to select one of purchase and record user options and then select the other user option in order to purchase and record the program. In other words, the claimed invention contemplates three different user options, namely, (i) a purchase and record option, (ii) a purchase option, and (iii) a record option.

Russo discloses a stored program pay-per-play system in which a user is responsible for payment only when, and if, the user chooses to select a program for replay or actually enjoys the program substantially in its entirety (see Abstract). As such, Russo fails to teach or suggest, *inter alia*, a purchase and record option, as claimed. With Russo, a user may provide a first input (e.g., a record command) that causes a program to be recorded. After the program is recorded, the user may then provide a second input (e.g., a play command) to initiate playback of the recorded program. Since the user is not responsible for payment until when, and if, he/she selects the program for replay or actually enjoys the program substantially in its entirety, this second input (e.g., a play command) may essentially represent a purchase option. It is noted that Russo fails to teach or suggest a single user option that both records a program and causes the recorded program to be played back (i.e., purchased). Therefore, it can be concluded that Russo discloses only a record option (e.g., a record command) and the equivalent of a purchase option (e.g., play command), and provides

absolutely no teaching or suggestion of a single user option that enables both program purchase and recording, as claimed. Accordingly, Russo fails to teach or suggest the inventions of claims 1, 3, 6, 8 and 13, and withdrawal of the rejection is respectfully requested.

Re: Claims 2, 4, 5, 7, 9, 10, 14 and 15

Claims 2, 4, 5, 7, 9, 10, 14 and 15 are rejected under U.S.C. § 103(a) as being unpatentable over Russo in view of LaJoie et al. Applicants respectfully traverse this rejection since LaJoie et al. is unable to remedy the deficiencies of Russo discussed above in conjunction with claims 1, 3, 6, 8 and 13.

As previously indicated herein, Russo discloses a stored program pay-per-play system in which a user is responsible for payment only when, and if, the user chooses to select a program for replay or actually enjoys the program substantially in its entirety (see Abstract). Russo fails to teach or suggest, *inter alia*, a purchase and record option, as claimed and described above. LaJoie et al. discloses a system in which the selection to record a program, and the selection to purchase the program require two separate and independent inputs by the user (see, for example, column 29, lines 33-58, and FIG. 25 of LaJoie et al.). That is, in all cases, LaJoie et al. requires a user to make two separate independent selections in order to both record and purchase a program, and is thereby unable to remedy the deficiencies of Russo. Accordingly, the proposed combination of Russo and LaJoie et al. fails to teach or suggest the inventions of claims 2, 4, 5, 7, 9, 10, 14 and 15, and withdrawal of the rejection is respectfully requested.

Re: Claims 11 and 12

Claims 11 and 12 are rejected under U.S.C. § 103(a) as being unpatentable over Russo in view of PCT Published Application WO 92/22983 (hereinafter, "Browne et al."). Applicants respectfully traverse this rejection for at least the following reasons.

With respect to independent claim 11, Applicants point out that this claim includes:

"an on screen user option indicating that a user can both purchase and record said program, so that the user does not have to select one of purchase and record user options and then select the other user option to purchase and record the selected program" (emphasis added)

As indicated above, independent claim 11 provides a user option that enables a user to both purchase and record a program without having to select one of purchase and record user options and then select the other user option in order to purchase and record the program. In other words, the invention of claim 11 contemplates three different user options, namely, (i) a purchase and record option, (ii) a purchase option, and (iii) a record option.

As previously explained herein, Russo discloses a stored program pay-per-play system in which a user is responsible for payment only when, and if, the user chooses to select a program for replay or actually enjoys the program substantially in its entirety (see Abstract), and fails to teach or suggest, *inter alia*, a purchase and record option, as claimed. Browne et al. fails to remedy this deficiency of Russo. In particular, Browne et

al. discloses an audio/video recording system that can be controlled by user input to allow for automatic recording of selected programs simultaneously input from multiple sources. However, Browne et al. provides absolutely no disclosure of a user option that enables a user to both purchase and record a program (i.e., a purchase and record option) without having to select one of purchase and record user options and then select the other user option in order to purchase and record the program, as claimed. Accordingly, the proposed combination of Russo and Browne et al. fails to teach or suggest the invention of claim 11, and withdrawal of the rejection is respectfully requested.

With respect to independent claim 12, Applicants point out that this claim includes:

“on screen display means for displaying a first list representing programs selected for recording;
first user control means for selecting to both purchase and record a program;
on screen display means for displaying a second list representing programs selected for purchasing;
second user control means for removing a selected program from said first and second lists; and
control means, in response to said user removal of said program from said second list, automatically removing said program from said first list.”

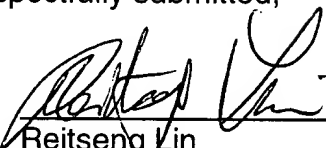
As indicated above, independent claim 12 defines an apparatus in which a program is automatically removed from a first list of programs selected for recording in response to user removal of the program from a second list of programs selected for purchase. The proposed combination of Russo and Browne et al. fails to teach or suggest the subject matter of independent claim 12.

As previously explained herein, Russo discloses a stored program pay-per-play system in which a user is responsible for payment only when, and if, the user chooses to select a program for replay or actually enjoys the program substantially in its entirety (see Abstract). Browne et al. discloses an audio/video recording system that can be controlled by user input to allow for automatic recording of selected programs simultaneously input from multiple sources. Neither of these references, whether taken individually or in combination, teaches or suggests an apparatus in which a program is automatically removed from a first list of programs selected for recording in response to user removal of the program from a second list of programs selected for purchase, as claimed. Accordingly, the proposed combination of Russo and Browne et al. fails to teach or suggest the invention of claim 12, and withdrawal of the rejection is respectfully requested.

Conclusion

In view of the foregoing amendments and remarks, Applicant believes that this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicant's attorney at (609) 734-6813, so that a mutually convenient date and time for a telephonic interview may be scheduled. No fee is believed due. However, if a fee is due, please charge the fee to Deposit Account 07-0832.

Respectfully submitted,

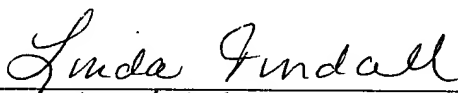

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Linda Tindall